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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,581	05/30/2001	Koki Uchiyama	CA1073	9236
23493	7590	05/02/2006	EXAMINER	
SUGHRUE MION, PLLC 401 Castro Street, Ste 220 Mountain View, CA 94041-2007			LE, MIRANDA	
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,581

Applicant(s)

UCHIYAMA, KOKI

Examiner

Miranda Le

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 7-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is responsive to Amendment filed 02/06/2006.
2. Claims 1-2, 7-22 are pending in this application.

The objection to the specification (drawings, claim objection) of the invention has been withdrawn in view of the amendment.

This action is made Final.

***Response to Amendment***

3. The DECLARATION filed on 02/06/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Blaser reference (US Patent No. 6,757,661 B1).

The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 attempts to show conception of the invention prior to the effective date of the reference 04/07/2000 coupled with due diligence from prior to the reference data to the filing date 05/30/2000 of the application (constructive reduction to practice).

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Blaser reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

*I. Conception*

A) Per MPEP 715, the essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. **FACTS, not conclusions, must be alleged.** Evidence in the form of exhibits may accompany the affidavit or declaration. **Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.**

A conception of an invention, through evidenced by disclosure, drawing, and even a model, is not a complete invention under the patent laws, and confers no rights on inventor, and has no effect on a subsequently granted patent to another, unless the inventor follows it with reasonable diligence with some other act.

B) General allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23.23 O.G. 1224 (Comm'r Pat. 183). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, **without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.**

C) The affidavit or declaration and exhibits must clearly explain which facts or data application is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ29 (CCPA 1974).

D) When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." However, in the affidavits the applicant recited "Exhibit A discloses various details of my invention" which only indicated a vague idea of conception is made prior to April 7, 2000. The requirement for the conception is more than a vague idea of how to show the problem; the means themselves and their interaction must be comprehended also. It is noted, Applicant only states "at least pages 14, 17-23, 25, 26, 4, 41 of Exhibit A disclose the features recited in claims 1, 2, 21, 22 of the present invention. However, applicant does not give any clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.

**The applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.** 505 F.2d at 718-19, 184 USPQ at 33. See also *In re HaMr*, 333 F.2d 920, 142-USPQ 164 (CCPA 1964) (Affidavit asserts that facts exist but does not tell what they are or when they occurred"). The statement which recited in paragraph 4 and 5, on page 2 are general allegation that the invention was complete prior to the date of the reference 04/07/2000 without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The declaration and the accompanying exhibit, do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore does not support conception of the claimed inventions.

## II. Diligence

A. In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

B. The critical period in which diligence must be shown begins just prior to the effective date of the reference 04/07/2000 or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

C. The conception occurs prior to the date of the reference, but reduction to practice afterward, it is not enough merely to allege that applicant or patent owner had been diligent. The exhibit(s) which was demonstrated by the application was not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the filing date 05/30/2000 in determining the sufficiency of 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference 04/07/2000 or activity ends with the date of a reduction to practice, either actual or constructive.

Per MPEP 2138.06,

**THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES.**

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 834, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading**). A 2-day period lacking

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activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Or. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts**).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Blaser reference (April 07, 2000) to the US filing date of this application (May 30, 2000) because applicant merely provide blank statements to support diligence between April 07, 2000 and May 30, 2000, without being specific as to dates and facts.

4. Applicant's arguments regarding Blaser is not available as a prior art reference because the claimed invention was conceived prior to 04/07/2000 and constructively reduced to practice on 05/30/2000 have been fully considered, but they are not persuasive for the reasons set forth in paragraph 3. Therefore, the rejection is maintained, Blaser is still available as a prior art.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 7-18, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Blaser et al. (US Patent No. 6,757,661 B1).

Blaser anticipated independent claims 1, 2, 3, 4, 5, 6, by the following:

**As to claims 1, 21**, Blaser teaches a method of retrieving information from one or more information sources in a search space, said method comprising: providing central program code at a central computer; said central program code being adapted for maintaining a central database of data records (OSP Server 130, Figs. 1, 2), for accessing information from said information sources (web Server 150, Figs. 1, 2), and for comparing said data records with said information from said information sources (col. 5, line 49 to col. 6, line 28);

recognizing communication between said central program code and remote program code (client 100) at least one of remote terminal (col. 5, line 49 to col. 6, line 28);

said remote program code being adapted for monitoring user activity at each of said plurality of remote terminals, for collecting monitored data related to said network activity, and for transmitting said monitored data to said central program code (col. 5, line 49 to col. 6, line 41, col. 9, lines 41-65, Figs. 1, 2);

supplementing, at said central computer, said data records in accordance with said monitored data to provide an augmented central database (col. 6, lines 28-56, col. 9, lines 19-65);

responsive to a request for information from said at least one user (user sends request to server 150), identifying candidate response information from said information sources at said central computer (col. 9, lines 3-65);

comparing contents of said augmented central database (OSP server 130 determines which targeted data needs to send to client) with said request and with said candidate response information at said central computer (col. 9, lines 19-65);

and as a result of said identifying and said comparing, transmitting, to said remote program code at said at least one remote terminal, data concerning one or more of said information sources which contain information relevant (Advertisement Information) to said request so as to progressively tailor information retrieval results (the display of advertisements that are dynamically targeted toward the user based upon the user's demographic profile, col. 10, lines 32-37) for said at least one user and provide said information retrieval results to said at least one user (col. 9, line 66 to col. 10, line 48, Fig. 5, step 540).

**As to claims 2, 22,** Blaser teaches an information retrieval system for accumulation and retrieval of data related to one or more information sources in a search space, said system comprising: remote program code at at least one remote terminal (client 100, Fig. 1, col. 5, line 49 to col. 6, line 4);

said remote program code being adapted for monitoring user activity at least one user, for collecting monitored data related to said user activity and to each of said information sources accessed by said at least one, and for transmitting said monitored data (receives an ad play list, col. 5, line 49 to col. 6, line 4, col. 10, lines 32-63, Figs. 1, 2);

and a central computer having central program code (OSP Server 130, Figs. 1, 2) receiving said monitored data transmitted from said remote program code (col. 9, line 19 to col. 10, line 28);

said central program code being adapted for maintaining a central database of data records and for accessing information from said information sources, and for comparing said data records with said information from said information sources (col. 5, line 49 to col. 6, line 41, col. 9, line 19 to col. 10, line 28);

wherein said central computer program code supplements said data records in accordance with said monitored data to provide an augmented central database (col. 9, line 19 to col. 10, line 28);

said central computer identifying candidate response information from said information sources in response to a request for information from said at least one user (col. 9, line 19 to col. 10, line 28), comparing contents of said augmented central database with said request and with said candidate response information (col. 9, line 19 to col. 10, line 28), and transmitting, to said remote program at said at least one of said plurality of remote terminals, data concerning one or more of said information sources which contain information relevant to said request so as to progressively tailor information retrieval results for at least one user and provide said information retrieval results to said at least one user (col. 6, lines 5-65, col. 10, line 14 to col. 11, line 15).

**As to claims 7, 13,** Blaser teaches wherein said monitored data comprises implicit data, including data selected from the group consisting of queries (the client application 100 sends

feedback information respecting these request and data accesses to the OSP Server 130) and actions taken after receiving responses to said queries (col. 9, lines 41-65), said implicit data being added iteratively to said central database to form said augmented central database so as to progressively tailor information retrieval results for said at least one user based on said implicit data (col. 9, lines 41-65, col. 10, lines 14-48).

**As to claims 8, 9, 14, 15,** Blaser teaches wherein said monitored data comprises explicit data including user input in response to one or more queries from said central computer (col. 6, lines 41-55), said user input including data selected from the group consisting of user profile information and user feedback concerning information retrieval results (col. 6, lines 41-55), said explicit data being added iteratively to said central database to form said augmented central database so as to progressively tailor information retrieval results for said at least one user based on said explicit data (col. 6, lines 41-55).

**As to claims 10, 16,** Blaser teaches said remote program code is adapted for monitoring user activity of a plurality of users at a respective plurality of remote terminals (col. 6, lines 5-65), for collecting said monitored data related to said user activity and to each of said information sources accessed by said plurality of remote terminals (col. 6, lines 5-65), and for transmitting said monitored data to said central program code (col. 6, lines 5-65);

said supplementing comprises supplementing said data records based on said user activity at said plurality of remote terminals to provide said augmented central database (col. 6, lines 5-65); and

said transmitting to said remote program code comprises progressively tailoring said information retrieval results for said at least one user based on said user activity at said plurality of remote terminals (col. 6, lines 5-65).

**As to claims 11, 17,** Blaser teaches said monitored data includes a plurality of user profiles, and wherein said central computer groups contents of said augmented central database based on said user profiles so as to tailor said information retrieval results for said at least one user based on one or more user profiles most closely matching a user profile of said at least one user (col. 6, lines 5-65).

**As to claims 12, 18,** Blaser teaches said information retrieval results include an identity of at least one other user with whom said at least one user then can communicate to obtain further information (col. 6, lines 5-65, col. 7, lines 21-34).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser et al. (US Patent No 6,757,661 B1), as applied to claims above, in view of Philyaw et al. (US Patent No. 6,836,799 B1).

**As to claims 19, 20**, Blaser does not expressly teach “said search space comprises the Internet and media programming comprising at least one of television programming and radio programming, so that said at least one user can access said media programming as a result of said information retrieval results”. However, Philyaw teaches this limitation at col. 4, lines 34-58, Fig. 1 (i.e. TV program 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Blaser with the teachings of Philyaw to include “said search space comprises the Internet and media programming comprising at least one of television programming and radio programming, so that said at least one user can access said media programming as a result of said information retrieval results”, because it would allow a television signal to trigger a computer response in which the consumer will be guided to a personalized web page and therefore, provide the consumer with the capability of responding to a wide variety of companies using this technology. One of ordinary skill in the art would be motivated to make this combination in order to offer a variety of services to users of online services.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

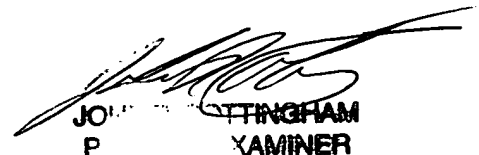
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on (571) 272-7079. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le  
April 28, 2006



JOHN R. COTTINGHAM  
P. EXAMINER